

REMARKS

We have addressed the Examiner's §112, first paragraph rejections in the amendments to the claims. In particular, we have amended claims 1 and 15, removing the language "allows an unobstructed passage across the threshold when in a compressed state." We submit that the amendments to claims 1 and 15 do not raise new issues for the Examiner that would necessitate a further search.

We further note that no prior art rejection was made as to claims 9, 11, and 13-15. Claim 9 has been re-written in independent form, incorporating all the limitations of the claims on which it previously depended. Applicant therefore respectfully requests claims 9, 11, and 13-15 be deemed allowable.

Prior Art Rejections

Examiner has additionally rejected claims 1-8, and 12 under 35 U.S.C. §103, citing DE-3514489 (hereinafter, Hack), in view of U.S. Pat. No. 6,094,757 (Torres) and U.S. Pat. No. 6,877,279 (Russell). Applicant traverses this rejection. The Examiner acknowledges that Hack does not disclose a recess for receiving an adhesive for attaching to a floor, but argues that both Torres and Russell disclose this feature. The Examiner further argues that it would have been obvious to a person of skill in the art to modify Hack to include a recess for receiving an adhesive as an attaching means, wherein so doing would amount to a mere substitution of one functional equivalent attaching means for another. We disagree.

We submit that a person of skill in the art would not modify Hack in the manner suggested by the Examiner because the collapsible outer shell of the Hack reference is disposed within a receptacle (item 7 in figure 9) and adequately secured there without adhesive tape. It would be redundant, therefore, to modify the outer shell in Hack to additionally secure it within the receptacle by adhesive. Indeed, such a securing strategy is inconsistent with the design feature of the receptacle itself: by using adhesive tape, the outer shell may simply be secured to the floor, as in the invention of the present application, without the need to construct a receptacle to hold the outer shell.

We believe that the Examiner's rejection is a hindsight reconstruction, using Applicant's claim as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior art. This is impermissible under the law. For example, in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1600)

The present rejection fits the court's description of what may not be done under § 103. The examiner has merely listed certain components of applicant's invention and then located isolated disclosures of those components. The law requires more than that.

The examiner must show where the prior art provides a motivation to combine the references he/she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

Claims 2-8 and 12 are dependent on claim 1, and are thus allowable for at least the reasons that claim 1 is allowable. Any circumstance in which the applicant has (a) addressed certain comments of the Examiner does not mean that the applicant concedes other comments of the Examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the Examiner's positions with respect to that claim or other claims.

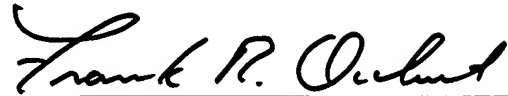
In light of the foregoing comments, the Applicant respectfully requests that all currently pending claims be deemed allowable.

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Respectfully submitted,

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